



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/633,897	08/07/2000	William A. Royall, Jr.	ROY B-747	3640

7590 12/19/2003

DUANE MORRIS LLP  
1667 K STREET NW  
SUITE 700  
WASHINGTON, DC 20006

EXAMINER
----------

OUELLETTE, JONATHAN P

ART UNIT	PAPER NUMBER
----------	--------------

3629

DATE MAILED: 12/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/633,897

Applicant(s)

ROYALL, JR. ET AL.

Examiner

Jonathan Ouellette

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 15-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of 1-14 in Paper No. 7 is acknowledged.

### ***Double Patenting***

2. The nonstatutory double patenting rejection is withdrawn, due to applicant's persuasive remarks.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
  - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
4. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over CollegeEdge ("CollegeEdge, the Leading Provider of Web-based Services to Educational Institutions, Announces Success of Enrollment Services System, Business Wire, March 1, 1999).
5. As per amended independent Claims 1 and 6, CollegeEdge discloses a method for profiling an inquiry pool of candidates in attending an institution of higher learning preliminarily to providing application for enrollment, the method comprising the steps of: (a) providing a data base including information related to candidates for enrollment and the preferences of the

Art Unit: 3629

institution for students with predetermined characteristics; (b) electronically evaluating the candidates in the data base against a first predetermined profile and (c) providing a report of the electronic evaluation ("CollegeEdge, the Leading Provider of Web-based Services to Educational Institutions, Announces Success of Enrollment Services System, Business Wire, March 1, 1999).

6. CollegeEdge fails to expressly disclose an inquiry pool of candidates interested in attending an identified institution of higher learning preliminarily to providing candidates from the pool with an application for enrollment.
7. However, CollegeEdge does disclose, wherein the website allows institutions to select profiles of students (candidate pool), and additionally allows institutions to provide customized, university-branded applications and information online (identified institution); furthermore, the system disclosed by CollegeEdge allows institutions to send students university-branded information, wherein the student can select to release their identity to the institution if interested ("CollegeEdge, the Leading Provider of Web-based Services to Educational Institutions, Announces Success of Enrollment Services System, Business Wire, March 1, 1999).
8. Therefore, It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the system for one *identified* institution, wherein the student places their information in a pool if *interested*, as the prior art discloses an advancement on the claimed invention by allowing multiple institutions the ability to access a multitude of interested students' information.

9. Furthermore, CollegeEdge fails to expressly disclose the first predetermined profile including: (i) to the extent available in the data base, information as to the candidate's high school class year, the prior visit of the candidate to the institution, and the source of the information about the candidate's initial contact with the institution in the data base, and (ii) the preferences of the institution.
10. However, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The candidate recruiting method would be performed regardless of the information included in the candidate profile. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).
11. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included information as to the candidate's high school class year, the prior visit of the candidate to the institution, and the source of the information about the candidate's initial contact with the institution in the data base, and the preferences of the institution in the first predetermined profile, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.
12. As per Claim 2, CollegeEdge discloses wherein the first predetermined profile includes the gender and ethnicity of each candidate; and wherein the report of the electronic reevaluation includes an evaluation of the degree of gender and ethnicity representation of the candidates in the database.

13. As per Claim 3, CollegeEdge discloses wherein the first predetermined profile also includes the geographic area residence of each candidate; and wherein the report of the electronic reevaluation also includes an evaluation of the degree of geographic area of residence representation of candidates in the database.
14. As per Claims 4 and 7, CollegeEdge discloses (d) preparing a mailing list as a function of evaluated interest.
15. As per Claims 5 and 8, CollegeEdge discloses wherein the data base includes a list of available documentation about the institution (relating to preselected features of the institution); and including the further steps of: (g) selecting documentation for mailing as a function of the profiling; and (h) mailing the selected documentation.
16. As per amended independent Claim 9, CollegeEdge discloses a method for evaluating the continued interest of candidates in attending an institution of higher learning preliminarily to providing the candidates with an application for enrollment, the method comprising the steps of: (a) providing a data base including information related to candidates for enrollment at an institution and the preferences of the institution for students with predetermined characteristics; (b) electronically evaluating the candidates in the data base against a first predetermined profile; and (f) providing a report of the electronic (re)evaluation (“CollegeEdge, the Leading Provider of Web-based Services to Educational Institutions, Announces Success of Enrollment Services System, Business Wire, March 1, 1999).
17. CollegeEdge fails to expressly disclose wherein the institution is identified.
18. However, CollegeEdge does disclose, wherein the website allows institutions to provide customized, university-branded applications and information online (identified institution)

(“CollegeEdge, the Leading Provider of Web-based Services to Educational Institutions, Announces Success of Enrollment Services System, Business Wire, March 1, 1999).

19. Therefore, It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the system for one *identified* institution - as the prior art discloses an advancement on the claimed invention by allowing multiple institutions the ability to access a multitude of interested students' information.
20. Furthermore, CollegeEdge fails to expressly disclose the first predetermined profile including: (i) to the extent available in the data base, information as to the candidate's high school class year, the prior visit of the candidate to the institution, and the source of the information about the candidate's initial contact with the institution in the data base, and (ii) the preferences of the institution.
21. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited, and it would have been obvious to one of ordinary skill in the art to include this data in the system disclosed by CollegeEdge (see rejection of independent Claims 1 and 6).
22. Finally, CollegeEdge fails to expressly disclose (c) electronically requesting predetermined information from the selected candidates; (d) entering the electronic responses to the electronic request for information into the database; (e) electronically reevaluating the selected candidates in the data base against a second predetermined profile to thereby evaluate the interest of the selected candidates in attending the institution.
23. However, CollegeEdge does teach the candidate filling out an initial profile survey - Universities selecting matching profiles and sending the candidate an electronic message

with additional information about the school and its programs ("CollegeEdge, the Leading Provider of Web-based Services to Educational Institutions, Announces Success of Enrollment Services System, Business Wire, March 1, 1999).

24. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to request more information from the candidates through the electronic message to clarify the candidate current standing (in regard to finding a college), and resubmitting the answers of the survey back through the evaluating system disclosed by CollegeEdge.
25. As per Claim 10, CollegeEdge discloses wherein the electronic request includes the steps of: constructing an electronic survey; locating the electronic survey on a web page at the web site of the institution; create a unique access number for each candidate; providing each candidate with his unique access number in an e-mail request for information by an electronic survey; and automatically updating the data base with the responses from the electronic survey.
26. As per Claim 11, CollegeEdge discloses (g) preparing a mailing list of selected candidates as a function of the evaluated continued interest.
27. As per Claim 12, CollegeEdge discloses wherein the data base includes a list of available documentation relating to preselected features of the institution; and including the further steps of: (h) selecting available documentation as a function of the electronic responses to the electronic request for information, and (i) mailing the selected documentation to each of the selected candidates on the mailing list.

28. As per amended independent Claim 13, CollegeEdge discloses a method for evaluating the continued interest of candidates in attending an identified institution of higher learning preliminarily to providing the candidates with an application for enrollment, the method comprising the steps of: (a) providing a data base including information related to candidates interested in enrollment at the identified institution and the preferences of the institution for students with predetermined characteristics; (b) electronically evaluating the candidates in the data base against a first predetermined profile; and (f) providing a report of the electronic reevaluation. (“CollegeEdge, the Leading Provider of Web-based Services to Educational Institutions, Announces Success of Enrollment Services System, Business Wire, March 1, 1999)
29. CollegeEdge fails to expressly disclose an inquiry pool of candidates interested in attending an identified institution of higher learning.
30. However, CollegeEdge does disclose, wherein the website allows institutions to select profiles of students, and additionally allows institutions to provide customized, university-branded applications and information online (identified institution); furthermore, the system disclosed by CollegeEdge allows institutions to send students university-branded information, wherein the student can select to release their identity to the institution if interested (“CollegeEdge, the Leading Provider of Web-based Services to Educational Institutions, Announces Success of Enrollment Services System, Business Wire, March 1, 1999).
31. Therefore, It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the system for one *identified* institution, wherein the student

places their information in a pool if *interested*, as the prior art discloses an advancement on the claimed invention by allowing multiple institutions the ability to access a multitude of interested students' information.

32. Furthermore, CollegeEdge fails to expressly disclose (c) providing a web page for the institution, the web page housing a survey requesting predetermined information related to the continued interest of candidates in enrolling at the institution; (d) sending an e-mail to the selected candidates directing them to the institution's web page; (e) electronically reevaluating the selected candidates in the data base against a second predetermined profile to thereby gauge the continued interest of the selected candidates in attending the institution.
33. However, CollegeEdge does teach a candidate filling out an initial profile survey - Universities selecting matching profiles and sending the candidate an electronic message with additional information about the school and its programs ("CollegeEdge, the Leading Provider of Web-based Services to Educational Institutions, Announces Success of Enrollment Services System, Business Wire, March 1, 1999).
34. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a website link or address in the electronic message to the candidate and to request additional information from the candidates to clarify the candidate current standing (in regard to finding a college), and resubmitting the answers of the survey back through the evaluating system disclosed by CollegeEdge.
35. As per Claim 14, CollegeEdge discloses wherein selected candidates are directed to the web page by a hyperlink, which uniquely identifies the candidates to whom the e-mail is sent so that the survey includes information relating to the candidates when it initially appears.

***Response to Arguments***

36. Applicant's arguments with respect to Claims 1-14 have been considered but are moot in view of the new ground(s) of rejection.
37. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
38. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

***Conclusion***

39. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (703) 605-0662. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.
40. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone numbers for the organization

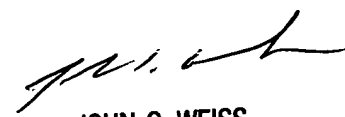
Art Unit: 3629

where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-3597 for After Final communications.

41. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5484.



jo  
December 16, 2003



JOHN G. WEISS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600